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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,138	02/18/2004	Kevin Corcoran	ORM / 242US	3385
26875	7590	09/06/2006	EXAMINER	
WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/781,138

Applicant(s)

CORCORAN ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-6 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/18/04 &amp; 6/29/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Applicant's election **without traverse** of Group II, claims 7-20, in the reply filed on 22 June 2006 is acknowledged. Claims 1-6 are withdrawn from further consideration as being directed to a non-elected invention.

### ***Specification***

2. The disclosure is objected to because of the following informalities:

Applicant uses inconsistent terminology to reference item numbers throughout the specification (for example, in paragraph [0033] the terms holders, slots and recesses are used to describe item number 44, and the term appliances is used to reference item 30, which was previously identified as a bracket).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites the limitation "the plurality" in line 1. There is insufficient antecedent basis for this limitation in the claim. Multiple pluralities are previously defined and it is unclear as to which of these pluralities the limitation refers. The

examiner interprets the passage "the packages of the plurality containing" to mean --the appliance packages containing--.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 7, 8, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Georgakis (US 4,898,276).

Claim 7: Georgakis discloses an organizer **10** with an organizer tray **11** having a set-up tray support **21** with structure to restrain the set-up tray relative to the organizer tray (sidewalls of **21**), and a plurality of holders **23**, each with structure **24/25** for holding an orthodontic appliance in a restricted orientation. It is well settled that it is possible for functional language to define structure, but that where no distinguishing structure has been defined, the claim is not patentable and is fully met by the reference. See *In re Swinehart*, 169 USPQ 226.

Claim 8: The sidewalls **24/25** of holders **23** are fully capable of receiving unspecified packages of appliances in the claimed manner (e.g. one of the blister-type, which is shaped to snugly fit into holders **23**). The recitation that an element is "configured to" perform a function is not a positive limitation but only requires the ability

to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Claim 13: Georgakis discloses the claimed invention, including the orthodontic brackets (Col. 4, lines 1-4) and the set-up tray (Col. 4, lines 7-11).

5. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Brown (US 4,191,291).

Brown discloses an organizer tray **12** having a set-up tray support **40** with structure **42/44** to restrain the orientation of the set-up tray **48**, and a plurality of holders **32/36** with structure capable of holding orthodontic appliances (see Figure 3) in a restricted orientation.

6. Claims 16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Chester et al (US 5,350,059; provided by applicant; hereinafter Chester).

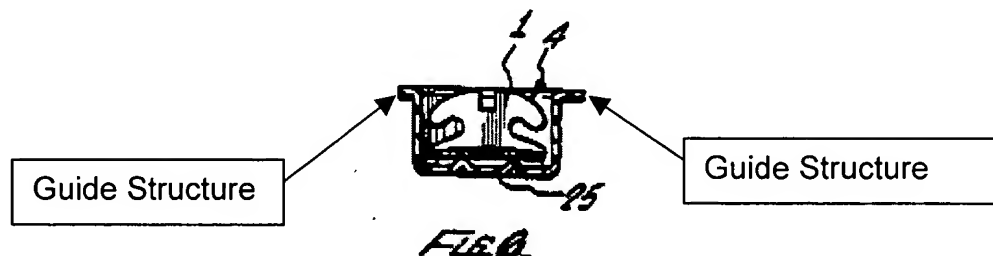
Claim 16: Insofar as the tray is not positively recited as structure, Chester discloses an orthodontic applicant package (see Figure 3) with a carrier 26 having a plurality of appliance constraining elements 22 having an orthodontic appliance 24 therein and restrained in the same orientation relative to carrier 26. The outer edges of carrier 26 constitute "guide structure" configured to fix the package relative to a tray (see Figure 6).

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Claim 20: As best determined by the examiner, the claim refers to each package having identical brackets, while the system contains a set of packages for differing teeth. Chester discloses the claimed system (see for example, Col. 6, lines 46-56).

7. Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by James (US 5,221,202; provided by applicant).

Insofar as the tray is not positively recited as structure, James discloses an orthodontic appliance package (see Figure 2), with a carrier **10** having a plurality of appliance constraining elements **11-17** therein, the constraining elements being cavities (see Figures 3 & 6) with surfaces **25** shaped to hold an orthodontic appliance as claimed (see for example, Figure 6), each constraining element having an orthodontic appliance **1** therein, and a guide structure (see below) that is fully capable of fixing the orientation of the package as claimed.



### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 7-10, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chester in view of Georgakis.

Claim 7: Chester discloses an organizer tray **30** with a plurality of holders (recesses formed by **60/64/66**) with structure **64/66** for holding an orthodontic appliance **22** in a restricted orientation (see Figure 6). Chester suggests the use of a set-up tray **34a/34b/34c** but does not expressly disclose a set-up tray support on the organizer tray.

Georgakis teaches a set-up tray support **21** on organizer tray **11** with structure to restrain the set-up tray relative to the organizer tray (sidewalls of **21**) for the temporary positioning of orthodontic brackets in readiness for intra-oral placement (Col. 4, lines 7-11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the tray of Chester with a set-up tray support as taught by Georgakis in order to temporarily position orthodontic brackets in readiness for intra-oral placement.

Claim 8: The structure of Chester is configured to receive a package of appliances (see Figure 6).

Claim 9: Chester discloses a recess having opposed slots **68** configured to receive a flange of a package of appliances (see Figure 6).

Claim 10: Chester discloses the holders on opposing sides of tray **30** (see Figure 6).

Claim 13: Chester-Georgakis, as applied to claim 7 above, discloses the claimed invention. Georgakis suggests the placement of set-up trays within the set-up tray support. Chester teaches the appliances of a set of orthodontic brackets.

Claim 14: Chester teaches a package of appliances (see Figure 6).

9. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Leigh (US 4,153,160).

Brown, as applied to claim 7 above, discloses the claimed invention except for the compartmented base.

Leigh discloses a compartmented base **12** movably attached to a tray **11** for storing instruments in an organized and accessible manner (see Abstract). Leigh teaches a variety of compartment shapes, a number of which would be fully capable of retaining unspecified set-up trays. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the tray of Brown with a compartmented base as taught by Leigh in order to store instruments in an organized and accessible manner.



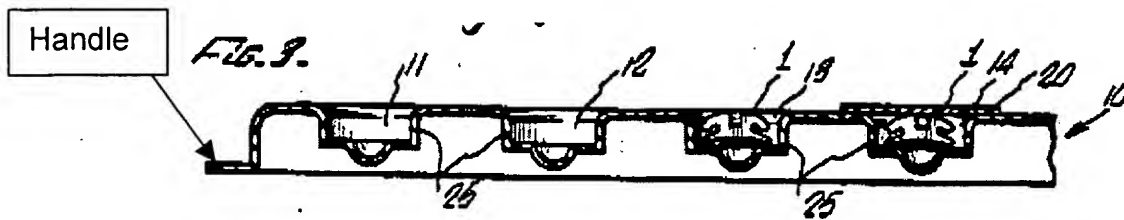
10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chester-Georgakis as applied to claim 14 above, and further in view of Roberts (US 622,396).

Chester-Georgakis, as applied to claim 14 above, discloses the claimed invention except for the compartmented base with a plurality of packages of orthodontic appliances.

Roberts discloses a compartmented base **B/B'/C** used to store bulk articles of items retained in an upper tray A. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the organizer of Chester-Georgakis with a compartmented base retaining a bulk number of the items retained on the tray (packages of orthodontic appliances, Chester 22), as taught by Roberts, in order to provide a large number of articles to the end user.

11. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over James.

James, as applied to claims 16 and 17 above, anticipates the flange on opposite sides of carrier **10** (see Figure 6, section 7 above), the orthodontic appliance as an orthodontic bracket arranged as claimed (see Figure 1) and confined as claimed. Moreover, James anticipates brackets **1** that are either the same, or differing brackets of a set (see Col. 3, lines 42-45). James further anticipates a flange (see below) at an end that is fully capable of functioning as a handle.



Although James does not expressly disclose the gingival edge of the bracket facing the handle, James suggests that the bracket need not be positioned as shown (Col. 3, lines 33-35). It would have been obvious to one of ordinary skill in the art to position the bracket of James in any desired orientation, including having the gingival edge of the bracket facing the handle, as claimed by the applicant. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Greg Pickett  
Examiner  
30 August 2006